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DECISION
ON PETITION

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PO BOX 747
FALLS CHURCH VA 22040-0747

In re Application of:
Paul Jeon, et al.
Application Serial No.: 09/880,857
Filed: June 15, 2001
For: **NETWORK INFRASTRUCTURE
INTEGRATED SYSTEM**

This is a decision on the petition filed October 6, 2004 under 37 CFR § 1.181 in regard to the Examiner's Refusal to enter an amendment after final Office action.

Petitioner states that the "...Amendment would not require further consideration..." and "the remarks attached to the Advisory Action do not present any reasoning in support of the conclusion that entry of the amendment for purposes of an appeal would require further consideration and/or search, thereby denying Applicants fundamental substantive and procedural due process as required under the Administrative Procedures Act. See in this regard, In re Zurko, 119 S.Ct. 1816, 50 USPQ 1930 (1999), and In re Gartside, 53 USPQ2d 1769 (Fed. Cir. 2000)."

A review of the file records reveals that a non-final Office action was mailed on July 16, 2003 wherein Claim 1 was rejected under 35 U.S.C. §102(b) as being anticipated by Applicants admission of prior art. Claims 2-5 were rejected under 35 U.S.C. §103 as being unpatentable over the combination of Applicant's admission of prior art in view of Bullock and claims 6-12 were rejected under 35 U.S.C. §103 as being unpatentable over the combination of Applicant's admission of prior art in view of Sanderson.

On November 17, 2003, Applicants responded to the outstanding non-final Office action by making minor amendments to the claims (e.g., spelling out acronyms), adding claim 13 and presenting arguments against the applied rejections

On February 11, 2004 the Office mailed a final Office action wherein the examiner's position continued to be that: claim 1 was anticipated by Applicant's admission of prior art, claims 2-5 were held as unpatentable under 35 U.S.C. §103 over the combination of Applicant's admission of prior art in view of Bullock and claims 6-12 were held as unpatentable over the combination of Applicant's admission of prior art in view of Sanderson. In addition claim 13 was held as being unpatentable under 35 U.S.C. § 103 over the combination of Applicant's admission of prior art in view of Nelson.

On July 12, 2004, Applicant's file an amendment after final Office action, requesting the incorporation of some of the limitations from claim 2 and claim 6 into the independent claim.

On August 19, 2004 the Office mailed an advisory action which indicated that the proposed amendment did not place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

Petitioner does not argue the finality of the Office action mailed February 11, 2004 within the instant petition.

MPEP §714.12 Amendments After Final Rejection or Action, states in part:

Once a final rejection that is not premature has been entered in an application, applicant or patent owner no longer has any right to unrestricted further prosecution. This does not mean that no further amendment or argument will be considered. Any amendment that will place the application either in condition for allowance or in better form for appeal may be entered. Also, amendments complying with objections or requirements as to form are to be permitted after final action in accordance with 37 CFR 1.116(b). Ordinarily, amendments filed after the final action are not entered unless approved by the examiner. See MPEP § 706.07(f), § 714.13 and § 1207. [emphasis added]

37 CFR §1.116. Amendments after final action or appeal, states in part:

(b) After a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913, amendments may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action. Amendments presenting rejected claims in better form for consideration on appeal may be admitted. The admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment under § 1.135, or the reexamination from termination. No amendment can be made in an inter partes reexamination proceeding after the right of appeal notice under § 1.953 except as provided for in paragraph (d) of this section. [emphasis added]

The amendment filed July 12, 2004 does not cancel claims or amend claims as a result of examiner requirement. The proposed amendment would not place the application in condition for allowance. Thus the only question is whether or not the amendment places the application in better form for appeal. Given that: (1) only some of the limitations of claims 2 and 6 are requested to be incorporated into the independent claim, (2) the proposed amendment would change the scope of the remaining dependent claims (e.g., Independent claim 1 and dependent claim 5 prior to the proposed amendment did not require a network bridge which included input protection means for protecting internal circuitry thereof and removing unwanted electric components of the data signal flowing between the telephone line network and the power line network, etc.), and (3) the scope of the independent claim would change, does not present the application in better form for appeal.

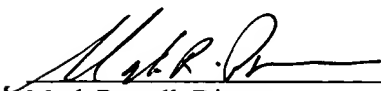
35 U.S.C. §134. Appeal to the Board of Patent Appeals and Interferences, states in part:

(a) PATENT APPLICANT. — An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the administrative patent judge to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal. [emphasis added]

Given that Applicant's claims have been twice rejected, Applicants have the opportunity to appeal to the Board of Patent Appeals and Interferences. Therefore, Applicants have not been denied "...fundamental substantive and procedural due process" as argued.

Accordingly, Applicant's petition to have the amendment after final entered is **DENIED**.

The file is being forwarded to the Technology Center's Central Files to await Applicant's Brief.



Mark Powell, Director
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Communications